



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,844	03/12/2001	Tadashi Ohta	108652	7819

25944 7590 09/19/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
----------	--------------

3639

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,844

Applicant(s)

OHTA, TADASHI

Examiner

Richard Woo

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03-12-01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

- 1) Applicant's amendments filed on June 27, 2005 have been acknowledged and entered.

Response to Arguments

- 2) Applicant's argument with respect to a rejection under 35 U.S.C. 112, 2nd paragraph has been fully considered and is persuasive. The previous rejection under 35 U.S.C. 112, 2nd paragraph has been withdrawn.
- 3) Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejection has been necessitated by the newly added limitation, "regardless of a **content** of the previous order".

Priority

- 4) Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

- 5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3639

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6) Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al. (US 6,154,295) in view of Nardozzi et al. (US 6,636,837).

As for Claim 1, Fredlund et al. discloses a print service comprising:

a recorder (26, computer) that records reception date of an order from the user and data identifying the user (col. 3, lines 28-39);

a receiver that receives a present print order from a user;

a checker that checks whether or not a previous order from the same user is in the record of the recorder within a predetermined period prior to the order of this (col. 3, lines 41-57); and

a charge determiner that deducts a predetermined amount from the print charge on the order of this time regardless of that on the previous order if the checker finds the previous order in the record (see col. 3, lines 41-57).

However, Fredlund et al. does not expressly disclose the system that provides a discount to the repeating customer regardless of a content of the previous order.

Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services, that the invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Freelund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Freelund et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that the invention provides a discount to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al., for the purpose of encouraging the customer to keep using and ordering the services in the future.

As for Claim 2, the modified system of Fredlund et al. further discloses the print service, wherein the predetermined period is less than one month (see col. 3, lines 50-51 of Fredlund et al.).

As for Claim 3, the modified system of Fredlund et al. further discloses the print service, wherein the checker includes a comparator that compares the user of the order of this time with the data identifying the user in the record (see the database and computer in Fig. 1 of Fredlund et al. to process the data to identify the user).

As for Claim 4, the modified system of Fredlund et al. further discloses the print service, wherein the checker includes a comparator that finds out a relationship between the

data of the order and the reception data in the record in view of the predetermined period (see Fig. 1 and col. 3, lines 41-57; col. 6, lines 21-35 of Fredlund et al.).

As for Claim 5, the modified system of Fredlund et al. further discloses the print service, wherein the comparator includes an adder that adds the predetermined period to the reception date in the record to compare it with the date of the order of this time (see col. 4, lines 39-55 of Fredlund et al.).

As for Claim 6, the modified system of Fredlund et al. further discloses the print service, wherein the comparator includes a subtractor that subtracts the predetermined period from the date of the order of this time to compare it with the reception date in the record (see Id.).

As for Claim 7, the modified system of Fredlund et al. further discloses the print service, wherein the comparator includes a finder that finds a period between the date of the order of this time and the reception date in the record to compare it with the predetermined period (see Supra columns 3, 4 of Fredlund et al.).

As for Claim 8, the modified system of Fredlund et al. further discloses the print service, wherein the checker checks up if the user used the same print service within the predetermined period (see Id.).

As for Claim 9, the modified system of Fredlund et al. further discloses the print service further comprising a reception that receives the order, wherein the checker checks up if the order is through the same reception within the predetermined period (see Supra columns 3, 4).

As for Claim 10, the modified system of Fredlund et al. further discloses the print service, wherein the contents to be recorded by the recorder are attached to the digital image data (col. 4, lines 24-38 of Fredlund et al.).

As for Claim 11, the modified system of Fredlund et al. further discloses the print service, wherein the contents to be recorded by the recorder are embedded in the digital image data (see Id.).

As for Claim 12, the modified system of Fredlund et al. further discloses the print service, wherein a plurality of predetermined periods are prepared in the checker (see Supra column 4).

As for Claim 13, the modified system of Fredlund et al. further disclose the print service, wherein the charge determiner deducts one of a plurality of predetermined amount from the print charges to cope with one of the predetermined periods (see Supra columns 3, 4).

As for Claim 14, Fredlund et al. discloses a print service comprising:

- a recorder that records reception date of an order from the user and data identifying the user (see Fig. 1 and col. 3, lines 15-40);
- a receiver that receives a present print order from a user;
- a checker that checks whether or not a previous order from the same user is in the record of the recorder within one month prior to the order of this time (see col. 3, lines 41-57; col. 4, lines 25-55); and

a charge determiner that deducts an amount from the print charge on the order of this time if the checker finds the previous order in the record (see Supra column 3).

However, Fredlund et al. does not expressly disclose the system that provides a discount to the repeating customer regardless of a content of the previous order.

Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services, that the invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Fredlund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Fredlund et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that the invention provides a discount to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al., for the purpose of encouraging the customer to keep using and ordering the services in the future.

As for Claim 15, the modified service system of Fredlund et al. further discloses the print service including a reception that receives the order, wherein the checker checks up if the user used the same print service within the predetermined period (see Fig. 1 and col. 3, lines 41-57; col. 6, lines 21-35 of Fredlund et al.).

As for Claim 16, the modified service system of Fredlund et al. further disclose the print service, wherein the checker checks up if the order is through the same service front within the predetermined period (see Supra column 3).

As for Claim 17, the modified service system of Fredlund et al. further disclose the print service including a laboratory system that produces the print in response to the order received through the service front (see Figs. 1, 4).

As for Claim 18, the modified service system of Fredlund et al. further disclose the print service, wherein the contents to be recorded by the recorder are attached to the digital image data (col. 4, lines 24-38).

As for Claim 19, the modified service system of Fredlund et al. further disclose the print service, wherein the contents to be recorded by the recorder are embedded in the digital image data (see Id.).

As for Claim 20, Fredlund et al. discloses a system comprising:

a recorder that records data identifying the user (see Supra Figs. and column 3);

a receiver that receives a present print order from the user;

a checker that checks whether or not the user used the same laboratory system before according to the record (see Id.);

a determiner that determines the print charge on the order of time in response to the checker (see Supra columns 3, 4); and

a reporter that reports the outcome of the determiner to a service front that contacts the user (62 in Fig. 1).

However, Fredlund et al. does not expressly disclose the system that provides a discount to the repeating customer regardless of a content of the previous order.

Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services, that the invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Fredlund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Fredlund et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that

the invention provides a discount to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al., for the purpose of encouraging the customer to keep using and ordering the services in the future.

As for Claim 21, the modified system of Fredlund et al. further discloses the system, wherein the determiner deducts a predetermined amount from the print charge on the order of this time regardless of that on the previous order by the same user if it is confirmed by the checker that the user used the same laboratory system before (see col. 3, lines 40-57).

As for Claim 22, the modified system of Fredlund et al. further discloses the system, wherein the service front is apart from the laboratory (see Figs. 1, 4).

As for Claim 23, the modified system of Fredlund et al. further discloses the system, wherein the checker checks up if the data identifying the user same as that of the order time has been recorded before (see Supra columns 3, 4).

As for Claim 24, the modified system of Fredlund et al. further discloses the system including a second recorder that records the service front receiving the order, wherein the reporter reports the service front recorded in the second recorder (see Figs. 1, 4 and Supra columns 3, 4).

As for Claim 25, the modified system of Fredlund et al. further discloses the system including a second recorder that records the service front in charge of the delivery of the

Art Unit: 3639

prints to the user, wherein the reporter reports the service front recorded in the second recorder (see Id.).

As for Claim 26, the modified system of Fredlund et al. further discloses the system, wherein the contents to be recorded by the recorder are attached to the digital image data (see Supra column 4).

As for Claim 27, the modified system of Fredlund et al. further discloses the system, wherein the contents to be recorded by the recorder are embedded in the digital image data (see Id.).

As for Claim 28, Fredlund et al. discloses a system comprising:

a first recorder that records data identifying the user (see Figs. 1, 4);

a second recorder that records a laboratory system, the service front requesting the recorded laboratory system to produce the print (see Supra Figs and column 3);

a receiver that receives a print order from the user;

a checker that checks whether or not the user used the same service front before according to the record of the first recorder (see Supra column 3); and

a determiner that determines the print charge on the order of this time in response to the checker regardless of the record of the second recorder (see Id.).

However, Fredlund et al. does not expressly disclose the system that provides a discount to the repeating customer regardless of a content of the previous order.

Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services, that the invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Freelund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Freelund et al..

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that the invention provides a discount to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al., for the purpose of encouraging the customer to keep using and ordering the services in the future.

As for Claim 29, the modified system of Fredlund et al. further discloses the system including a requester that requests the print to the laboratory system based on the second recorder (see Fig. 4 and Supra columns 3, 4).

As for Claim 30, the modified system of Fredlund et al. further discloses the system including a receiver that receives a report of a charge determined by the laboratory, and

Art Unit: 3639

a charging system that charges the user the total amount of the reported charge and the charge determined by the determiner (see "62" in Figs. 1 and 4 and the descriptions thereof).

As for Claim 31, the modified system of Fredlund et al. further discloses the system, wherein the service front acts as a reception site that receives an order for printing images from the user (see Supra Figs.).

As for Claim 32, the modified system of Fredlund et al. further discloses the system, wherein the service front acts as a delivery site that delivers the print output to the user (see Figs. 1, 4 for the delivery).

As for Claim 33, the modified system of Fredlund et al. further discloses the system, wherein the determiner determines lower charge if it is confirmed by the checker that an order from the same user was received within a predetermined period prior to the order of this time (see Supra columns 3, 4).

As for Claim 34, the modified system of Fredlund et al. further discloses the system, wherein the predetermined period is less than one month (see Supra column 3).

As for Claim 35, the modified system of Fredlund et al. further discloses the system, wherein the checker checks up if the data identifying the user same as that of the order time has been recorded before (see Supra column 3).

As for Claim 36, the modified system of Fredlund et al. further discloses the system, wherein the contents to be recorded by the first and second recorders are attached to the digital image data (see Supra column 4).

Art Unit: 3639

As for Claim 37, the modified system of Fredlund et al. further discloses the system, wherein the contents to be recorded by the first and second recorders are embedded in the digital image data (see Id.).

Conclusion

7) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

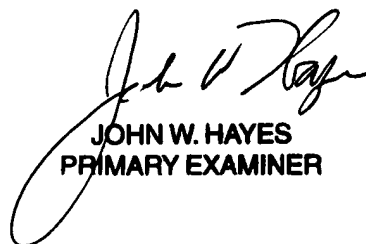
Art Unit: 3639

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3639
September 14, 2005



JOHN W. HAYES
PRIMARY EXAMINER